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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,539	12/20/2005	Alois Maier	HUBR-1288	8668
24972 7590 11/17/2009 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER LEONARD, MICHAEL L	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 11/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,539	<b>Applicant(s)</b> MAIER ET AL.	
	<b>Examiner</b> MICHAEL LEONARD	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-70 is/are pending in the application.
- 4a) Of the above claim(s) 30-59 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group III, concerning claims 60-69 in the reply filed on 2/13/2009 is acknowledged. The traversal is on the ground(s) that U.S. Patent Pub. No. 2004/0192835 to Stedil does not anticipate the common inventive feature of the inventions of Groups I to III because the reference does not antedate the filing date of the instant application. The applicants' showed diligence and a translated copy of the foreign priority document to overcome the reference. The initial argument that the U.S. document does not anticipate the common inventive feature of the claims is acknowledged. However, upon further search U.S. Patent Pub. No. 2002/0041965 to Hanada does meet the claimed language. Hanada discloses a one or two component polyurethane system having fluorinated side chains that is used to impart oil and water repellency to leather products (0002). Hanada discloses in Table 1-1, the reaction product between a fluoroine-containing diol (component A1 of instant application), polymer diol, with molecular weights of 2000 (component A2), 1,4-butanediol curative (component D, crosslinker), an isocyanate component (Component B1), catalyst and solvents (Page 8, Table 1-1) and Hanada further discloses that the weight percentage of fluorine in the system ranges from 3 to 80%, which meets the claimed language of 1-4%.

The requirement is still deemed proper and is therefore maintained..

Claims 30-59 and 70 are withdrawn from further consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 60-64 and 67 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103 (a) as obvious over 2002/0041965 to Hanada et al.

As to claim 60, Hanada discloses a one or two component polyurethane system having fluorinated side chains that is used to impart oil and water repellency to leather products (0002). Hanada discloses in Table 1-1, the reaction product between a fluoroine-containing diol (component A1 of instant application), polymer diol, with molecular weights of 2000 (component A2), 1,4-butanediol curative (component D, crosslinker), an isocyanate component (Component B1), catalyst and solvents (Page 8, Table 1-1) and Hanada further discloses that the weight percentage of fluorine in the system ranges from 3 to 80%, which meets the claimed language of 1-4%.

Hanada differs slightly from the claim language, because the examples that were exemplified show a percentage of fluorine that is outside the claimed language.

However, Hanada does disclose a range of from 3 to 80% for the fluorine content, which overlaps the claimed range of 1-4%. Furthermore, "a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments." *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). As a result, the examiner is taking the position that a person of ordinary skill in the art would read the disclosure of Hanada and presume that the language is broad enough to read over the

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claimed language of 1-4% of the instant application and without a showing of some unexpected results, the examiner will continue to rely on this prior art (0042 and 0049).

Furthermore, Hanada discloses that the preferable fluorine content and polysiloxane content in the fluorine-containing polyurethane according to the present invention will vary depending upon its application purpose, so that it is desired to obtain each fluorine-containing polyurethane with fluorine and polysiloxane segment contents suited for its application purpose. And considering the variety of applications that this fluorine-containing polyurethane can be used for to impart oil and water repellency a person of ordinary skill in the art would attempt many percentages of fluorine contents included in the range of 3-80% disclosed by Hanada to obtain the best coating that will improve the oil and water repellency of the substrate applied.

As to claims 61-64 and 67, Hanada discloses leather as a suitable substrate to apply the coating (0002).

Claims 65-66, 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0041965 to Hanada et al. that has been explained above and is applied here as such in view of U.S. Patent Pub. No. 2003/0026997 to Qiu et al.

As to claim 65, Hanada fails to disclose wherein the coating is used for the specific substrates of claim 65.

However, Qui discloses a fluorine-containing polyurethane, wherein the amount of fluorochemical composition in amounts sufficient to achieve the desired repellency

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properties for a particular application in amounts ranging from 0.1 to about 10 percent by weight (0146) and wherein the substrates can be chosen from a variety of substrates including glass, ceramic, concrete, wood, metals, etc. (0035)

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the fluorine-containing polyurethane of Hanada that is used to impart oil and water repellency to certain substrates on the same substrates disclosed by Qui because both compositions are designed for the very same purpose and a person of ordinary skill in the art could assume that the composition of Hanada would impart the same oil and water repellency characteristics of the substrates of Quid because the compositions are so similar.

Furthermore, "It is prima facie obvious to combine two compositions, fluorine-containing polyurethane compositions, each of which is taught by the prior art to be useful for the same purpose, impart oil and water repellency to substrates, in order to form a third composition to be used for the very same purpose, a substrate with improved oil and water repellency.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850,205 USPQ 1069, 1072 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments with respect to claim 39-70 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LEONARD whose telephone number is (571)270-7450. The examiner can normally be reached on Mon-Fri 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL LEONARD/  
Examiner, Art Unit 1796

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796